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Appl. No. 10/057,929
Amendment dated March 2, 2004
Reply to Office Action of January 2, 2004

Remarks

Claims 1-20 are pending in the application. Claims 15-20 are withdrawn from consideration. Claim 1 has been amended.

Based on the present Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Objection to the Drawings

The drawings have been revised to overcome the objection. Specifically, articles a-d, e-f, and g-i have been separated into Figs. 1-3, respectively, and Figs. 2-5 have been renumbered as Figs. 4-7. The Specification has been amended to correspond to the revised drawings.

Rejection Under 35 U.S.C. 112, second paragraph.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph for reciting "means...for compensating for departure of quantities of filter material from predetermined quantities." Claim 1 has been amended slightly to recite "means...for compensating for departures of quantities of filter material from predetermined quantities." It is respectfully submitted that this amendment does not change the scope of the claim, and thus, should be entered.

"Departure" is defined as "a variation that deviates from the standard or norm." Dictionary, Princeton Publishing. An alternative definition is "a divergence or deviation, as from an established rule, plan, or procedure." Webster's Dictionary. The "predetermined quantities" is the amount (or quantity) of the filter material that is expected or normal (or that which is determined beforehand, i.e., predetermined). As such, the "departures of quantities of filter material from predetermined quantities" occurs when the composite mouthpiece receives more or less filter material than is expected, and the compensating means compensates for this occurrence.

It is respectfully submitted that the claimed recitation is definite, particularly when considered by one skilled in the art reading the present specification.

As a generally matter, MPEP 2173.02 states about definiteness: "The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonably degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure...The test for definiteness is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." See also, Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 1 USQP2d 1081, 1088 (Fed. Cir. 1986).

The claim language at issue invokes 35 U.S.C. 112, sixth paragraph by reciting "means plus function." On this point, MPEP 2181 states: "The following guidance is provided to determine whether applicant has complied with the requirements of 35 U.S.C. 112, second paragraph when 35 U.S.C. 112, sixth paragraph is invoked: (A) If the corresponding structure, material or acts are described in the specification in specific terms...and one skilled in the art could identify the structure, material or acts from that description, then the requirements of 35 U.S.C. 112, second and sixth paragraphs are satisfied." See also, Atmel Corp. v. Information Storage Devices Inc., 53 USPQ2d 1225, 1228 (Fed. Cir. 1999).

In this case, the corresponding structure, material or acts are clearly described in the specification in specific terms. For example, see elements 25, 28 of Figs. 1 and 6 or part 40 or Fig. 5, and corresponding description.

Moreover, one skilled in the art would be able to identify this structure. In fact, the terms used in the claim are used in the specification. Reference is made to the following passages of the specification:

Page 7, lines 8-11 state: "Another object of the invention is to provide a novel and improved method of compensating for departures of supplies of flowable filter material in a series of successive filter mouthpieces from an optimum quantity."

Page 12, lines 9-11 state that the machine of the present invention comprises: "means for compensating for departures of quantities of filter material from predetermined or preselected or acceptable quantities." (emphasis added).

Page 27, lines 4-11 state: "The parts 25, 28 of the machines shown in Figs. 1 and 6 or the part 40 of the machines shown in Fig. 7 can be said to constitute a compensating device or compensating means the primary purpose of which is to compensate for differences in the heights of cellulose acetate plugs or wads or segments or elements and correspondingly differently high paper segments and fleeces segments as wells as different fillers of granulate. For example, if the quantity of flowable filter material is insufficient, the absence of compensating means would result in such introduction of a plug 20 or 30 that the sleeve would contain an embolys spaces (as shown at h in Fig. 3) which could enable the flowable filter material 26 to rattle in the finished filter mouthpiece. The compensating means (25, 28) ensures that the plug 20 descends to the level shown at i in Fig. 1 so that the supply 26 of flowable filter material is held between the plugs 19 and 20 without any, or without any appreciable, freedom of movement and resultant generation of noise." (emphasis added).

As such, one skilled in the art would clearly recognize the compensating means recited by the claims. The particular terms of the claims are used and the structure is fully described. Accordingly, the degree of definiteness required by 35 U.S.C. 112, second paragraph is satisfied, and nothing more is required. Accordingly, withdrawal of the rejection of claims 1-14 under 35 U.S.C. 112 is respectfully requested.

It is noted that the Examiner, in the Response to Arguments, suggests that the claims be amended to recite that the compensating means enables a longer or shorter than anticipated

movement. It is respectfully submitted that this is not necessary under 35 U.S.C. 112, second or sixth paragraph. The claim recites means plus function, and describes the corresponding structure performing that function in the specification. As such, the statutory requirements are satisfied.

Rejection under 35 U.S.C. 102

Claims 1, 2 and 4-7 stand rejected under 35 U.S.C. 102 as being anticipated by U.S. Patent No. 3,603,058 to Schubert.

Reconsideration of the rejection of claim 1 in view of Schubert is respectfully requested. Claim 1 recites "means...for compensating for departures of quantities of filter material from predetermined quantities..."

It is important to consider in this regard that claim 1 recites more than a "compensating means." Claim 1 recites "means...for compensating for departures of quantities of filter material from predetermined quantities..." As stated by the MPEP: "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

In the present invention, the compensating means compensates for a departure in the quantity of filter material from predetermined quantities. In other words, the compensating means compensates when the filter material is more than or less than what is expected. Less than the expected or predetermined amount of filter material results in a longer movement of the transfer device 17 than is normal. Conversely, more than the expected or predetermined amount of filter material results in a shorter movement of the transfer device than is normal. Generally, the compensating means is intended to eliminate excess spaces in the filter material formed when the tobacco material is less than usual.

Schubert fails to teach the "means for compensating for departures in the quantity of filter material from predetermined quantities."

As teaching the "compensating means" feature of claim 1, the Action generally cites Figs. 2-7 of Schubert. In Schubert, the top ram/plunger 46 is guided by cam surface 47. Spring 52 maintains

the ram 46 against the cam surface 47. Similarly, the bottom plunger 3 is guided by roller follower 29 tracking the face of cam surface 4. Spring 31 maintains the plunger 3 against the cam surface 4. The cam surfaces 4, 41 are stationary and unyielding and do not "compensate" for anything, and particularly, does not compensate for departures in the quantity of filter material. In other words, the plungers follow the same path and extend the same distance for every cycle.

In addition to failing to disclose such a compensating means, Schubert neither appreciates nor recognizes an advantage of such a compensating means. According to Schubert, the device described therein results in "an accurately determined amount of granular material." (col. 6, lines 53-54). Schubert also states "each of a succession of filter tips contains the same quantity of granular filter material and...the space occupied by such granular material in each of a series of successively produced filter tips is the same." (col. 2, lines 12-16). Thus, Schubert does not account for or consider that a less than optimum amount of tobacco material could be delivered, and thus, cannot disclose or suggest a "means for compensating for departures in the quantity of filter material from predetermined quantities" because there is no departure from the predetermined quantity.

Furthermore, claim 1 invokes 35 U.S.C. 112, sixth paragraph by reciting "compensating means." See MPEP 2181. In such instances, the Federal Circuit has stated "the U.S. Patent and Trademark Office may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability opinion." In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). The Action must not only show that the prior art structure performs an identical function as that specified in the claim (i.e., a "compensating" means), but "under Donaldson, an Examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." (emphasis added) MPEP 2182. The Action has failed to show how the structure in Schubert is identical or equivalent to the corresponding structure described in the present specification, as required by the Federal Circuit and the MPEP. In other words, the Action must show that Schubert not only discloses a structure that "compensates" (even as broadly interpreted by the Examiner), but

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the Action must show that the structure in Schubert is identical or equivalent to that disclosed in the present specification.

It is respectfully submitted that the structure in Schubert is not identical to that of the present invention. The compensating means of the present invention includes a spring 28 that can urge the plunger 17 to a level below which is normal or expected as compared to a predetermined distance or level. Particularly, spring 28 bears against collar 31 to urge the plunger 17 downward into the tube (page 19, line 12 – page 20, line 4). Other elastic compensating means, for example foam, can also be used. Although Schubert teaches the use of a spring, the springs of Schubert are used to urge the plunger away from the tube. The movement of the plunger in Schubert is guided by unyielding cam faces and roller followers. The cam arrangement is not a "compensating means", and more particularly, the structure of Schubert is not identical or equivalent to that described in the specification.

Accordingly, claim 1 distinguishes over Schubert and is allowable over Schubert.

Claims 2 and 4-7 depend from claim 1 and are allowable as depending from an allowable claim.

Rejection under 35 U.S.C. 103

Claims 3, 8, 9 and 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 3,603,058 to Schubert. Claims 3, 8, 9 and 12-14 depend from claim 1 and are allowable as depending from an allowable claim.

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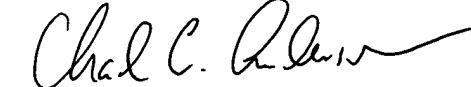
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. A Notice of Allowance with claims 1-20 is respectfully requested.

If this Response is unsuccessful in resulting in the allowance of this application, Applicant's Representative respectfully requests an interview with the Examiner and his Supervisor to discuss the outstanding rejections. Even if the interview also does not result in the allowance of the application, an interview may simplify the issues during the subsequent appeal.

Respectfully submitted,

Date: 03/02/04



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APPENDIX